Response to Office Action Mailed August 12, 2003

A. Claims in the Case

Claims 1-56 have been rejected. Claims 1, 17, 31, and 47 have been amended. Claims 10, 26, 40, and 52 have been cancelled. Claims 1-9, 11-25, 27-39, 41-51, 53-56 are pending.

B. Amendments

Applicant submits that the amendment made to the claims were for clarification purposes. Support for the amendments to the claims can be found, for example, in original claims 10, 26, 40 and 52. As such, Applicant submits that no new matter has been added to the claims.

C. The Claims Are Not Obvious Over Huffman in View of Kuwamoto Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-4, 9, 16-20, 25, 30-34, 39, 46-49, and 56 as being obvious over U.S. Patent No. 5,870,711 to Huffman (hereinafter "Huffman") in view of U.S. Patent Application No. 5,870,711 to Kuwamoto et al. (hereinafter "Kuwamoto") under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Amended claim 1 is directed toward a method includes a combination of features including, but not limited to, "the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value". Neither Huffman nor Kuwamoto appear to disclose, teach, or suggest at least this feature.

Claims 17, 31, and 47 describe features similar to claim 1. Claim 17 describes a combination of features including but not limited to "wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value." Applicant submits that the combination of Huffman and Kuwamoto does not appear to teach or suggest the features including but not limited to the above-mentioned features of claim 17 or claims 18-25 and 27-30 dependent on claim 17.

Claim 31 describes a combination of features including but not limited to "wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value." Applicant submits that the combination of Huffman and Kuwamoto does not appear to teach or suggest the features including but not limited to the above-mentioned features of claim 31 or claims 32-39 and 41-46 dependent on claim 31.

Claim 47 describes a combination of features including but not limited to "wherein the insurance claims comprises bodily injury claims, and wherein said processing the insurance claims comprises processing the bodily injury claims to estimate bodily injury general damages values." Applicant submits that the combination of Huffman and Kuwamoto does not appear to teach or suggest the features including but not limited to the above-mentioned features of claim 47 or claims 48-51 and 53-56 dependent on claim 47.

D. The Claims Are Not Obvious Over Huffman in View of Kuwamoto And Further In View of Ertel Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 5, 11-13, 15, 21, 27-29, 35, 41-43, 45, 50, and 53-55 as being obvious over Huffman in view of Kuwamoto and further in view of U.S. Patent No. 5,307,262 to Ertel (hereinafter "Ertel") under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant submits, for at least the reasons stated above, that independent claims 1, 17 31, and 47 and the above-listed claims dependent thereon are patentable over the combination of Huffman, Kuwamoto and Ertel.

E. The Claims Are Not Obvious Over Huffman in View of Kuwamoto And Further In View of Winans Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 6, 22, 36, and 51 as being obvious over Huffman in view of Kuwamoto and further in view of U.S. Patent No. 5,307,265 to Winans (hereinafter "Winans") under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant submits, for at least the reasons stated above, that independent claims 1, 17 31, and 47 and the above-listed claims dependent thereon are patentable over the combination of Huffman, Kuwamoto and Winans.

F. The Claims Are Not Obvious Over Huffman in View of Kuwamoto And Further In View of McGauley Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 7-8, 23-24, and 37-38 as being obvious over Huffman in view of Kuwamoto and further in view of U.S. Patent No. 5,899,998 to McGauley (hereinafter "McGauley") under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant submits, for at least the reasons stated above, that independent claims 1, 17 31, and 47 and the above-listed claims dependent thereon are patentable over the combination of Huffman, Kuwamoto and McGauley.

G. The Claims Are Not Obvious Over Huffman in View of Kuwamoto And Further In View of Abbruzzese Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 10, 14, 26, 40, 44, and 52 as being obvious over Huffman in view of Kuwamoto and further in view of Abbruzzese under 35 U.S.C. § 103(a). Applicant respectfully disagrees.

Amended claim 1 is directed toward a method includes a combination of features including, but not limited to, "the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value". Amended claim 1 includes at least some features from original claim 10.

The Examiner cites Abbruzzese et al. (U.S. Patent No. 5,557,515) with respect to this feature. While the Examiner has pointed to charts in Abbruzzese which provide an injury code, Abbruzzese does not appear to teach "processing the bodily injury claim to estimate a bodily injury general damages value" as recited in claim 1. In addition, the Examiner has not provided any reference points in Abbruzzese for this teaching. Applicant's specification states:

> In one embodiment, on receiving a trauma-induced bodily injury, a customer may file an insurance claim with his/her insurance organization to cover medical and other accident-related expenses. An IC may utilize a computer-based insurance claim processing system to process insurance claims. In one embodiment, the processing may include estimating a value associated with the filed insurance claim. (Applicant's specification, page 9, lines 1-5).

Abbruzzese appears to be directed towards a work management system to keep track of the status of processing a claim. Abbruzzese does not appear to disclose estimating a bodily injuries general damages value using a computer program.

In addition, Huffman, Kuwamoto, and Abbruzzese are not properly combinable. As stated in the MPEP §2142:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Huffman, Kuwamoto, and Abbruzzese either in the references or in the prior art. As further stated in the MPEP §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Applicant asserts that the Examiner appears to have used impermissible hindsight in trying to combine Huffman, Kuwamoto, and Abbruzzese. Applicant asserts it would not have been

obvious to one skilled in the prior art at the time the invention was made to combine Huffman (a cargo claims management system) with Kuwamoto (an application program help information control system) and Abbruzzese (a work management system). Applicant asserts claim 1 and claims 2-9 and 11-16, dependent on claim 1 are allowable.

Claims 17, 31, and 47 describe features similar to claim 1. Claim 17 describes a combination of features including but not limited to "wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value." Applicant submits that for at least the same reasons cited above claim 17, and the claims dependent from claim 17, are patentable over the combination of Huffman, Kuwamoto, and Abbruzzese.

Claim 31 describes a combination of features including but not limited to "wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value." Applicant submits that for at least the same reasons cited above claim 31, and the claims dependent from claim 31, are patentable over the combination of Huffman, Kuwamoto, and Abbruzzese.

Claim 47 describes a combination of features including but not limited to "wherein the insurance claims comprises bodily injury claims, and wherein said processing the insurance claims comprises processing the bodily injury claims to estimate bodily injury general damages values." Applicant submits that for at least the same reasons cited above claim 47, and the claims dependent from claim 47, are patentable over the combination of Huffman, Kuwamoto, and Abbruzzese.

H. Summary

Based on the above, Applicant submits that all of the claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted, or if any additional fees are required, please charge those fees to 50-1505/5053-36200/EBM.

Respectfully submitted,

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